

PATENT  
Customer No. 22,852  
Attorney Docket No. 02734.0341-01000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: )  
Kang C. YEH et al. )  
Application No.: 10/022,538 ) Group Art Unit: 1731  
Filed: December 20, 2001 ) Examiner: P. Chin  
For: METHOD OF MAKING A NON )  
COMPACTED PAPER WEB )  
CONTAINING REFINED LONG )  
FIBER USING A CHARGE )  
CONTROLLED HEADBOX AND A )  
SINGLE PLY TOWEL MAKE BY )  
THE PROCESS )

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8**

I hereby certify that this correspondence is being deposited with the United States Postal Services under 37 C.F.R. § 1.8 on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

on May 17, 2004  
Date

  
Barry Biddle

Enclosures:

1. Three-Month Petition for Extension of Time - 1 page
2. Request for Continued Examination Transmittal - 1 page
3. Request for Reconsideration - 9 pages
4. Postcard



PATENT  
Customer No. 22,852  
Attorney Docket No. 02734.0341-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
Kang C. YEH et al. ) Group Art Unit: 1731  
Application No.: 10/022,538 ) Examiner: P. Chin  
Filed: December 20, 2001 )  
For: METHOD OF MAKING A NON )  
COMPACTED PAPER WEB )  
CONTAINING REFINED LONG )  
FIBER USING A CHARGE )  
CONTROLLED HEADBOX AND A )  
SINGLE PLY TOWEL MADE BY )  
THE PROCESS )

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**REQUEST FOR RECONSIDERATION**

Applicants respectfully request reconsideration of the pending claims in view of the following remarks.

**REMARKS**

Currently, claims 16-30 are pending in this application. No claim has been amended.

First, Applicants would like to thank Examiner Chin for the courtesies that he extended to Applicants' representative during an interview on May 4, 2004. Applicants discussed the outstanding rejection of claims 16-30 and the Declaration previously

presented by Gary Worry. Applicants also discussed additional evidence which might be submitted to support Applicants' case. No agreement was reached during the interview. After reviewing Applicants' arguments herein, should the Examiner consider further evidence necessary to secure allowance of the claims of the instant application, he is requested to contact Applicants' undersigned representative.

The Examiner continues to reject claims 16-30 under the doctrine of obviousness-type double patenting over claims 1-8 of U.S. Patent No. 6,419,789. Claims 16-30 also stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,318,669 to *Dasgupta* in view of U.S. Patent No. 5,397,435 to *Ostendorf et al.* or U.S. Patent No. 5,437,766 to *Van Phan et al.* Applicants respectfully traverse these rejections.

I. **Obviousness-Type Double Patenting Rejection**

All claims continue to stand rejected under the doctrine of obviousness-type double patenting over claims 1-8 of U.S. Patent No. 6,419,789. Applicants again respectfully request that this rejection be held in abeyance until allowable subject matter is indicated.

II. **The Claims Are Not Obvious Over the Cited Prior Art**

The Examiner rejected claims 16-30 under 35 U.S.C. § 103(a) as obvious over *Dasgupta* in view of *Ostendorf et al.* or *Van Phan et al.* The Examiner claims that *Dasgupta* discloses tissue and paper towels which contain the claimed cationic wet strength agent and anionic dry strength agent in a ratio of 1/20 to 10/1 at a concentration of 0.1 to 2% by weight. The claimed strength, stiffness, and stretch

characteristics are said to be "obvious optimizations" in view of the teachings of *Ostendorf et al.* or *Van Phan et al.* The Examiner also states that "[w]hether or not the [amount of] cationic wet strength agent and anionic dry strength agent [added] to the pulp [is controlled] during the process of making the paper is moot because the amount of these agents in the final paper product is the same." This rejection is respectfully traversed.

The Examiner has failed to establish a *prima facie* case of obviousness, as required by law. Specifically, the Examiner has not set forth any teaching from the prior art which shows the claimed ranges for machine direction stretch, cross-direction wet strength, or tensile modulus of stiffness which are achieved by the present invention. Thus, the Examiner's conclusion that the cited references disclose final products with the same strength, softness and absorbency characteristics displayed by the present invention is unsupported. Moreover, the Examiner's assertion that such characteristics may be achieved by mere optimization of the amount of wet strength agent, softening agents, or foreshortening of the web as disclosed in *Ostendorf et al.* or *Van Phan et al.* is erroneous because these references do not teach compositions which possess the characteristics of the claimed products, nor would it have been obvious to one of skill in the art to obtain these characteristics.

Applicants submit that obtaining products with the same superior strength, softness, and absorbency as the products of the present invention is not merely "obvious optimization" of the prior art processes. As noted in the specification, the production of "away-from-home" paper towels is typically constrained by cost concerns. The prior art products cited in the specification, as well as those cited by the Examiner,

have addressed these cost concerns by producing products with low strength, softness, or absorbency. However, through the use of the present invention, Applicants have been able to maintain a low-cost product while improving strength, softness, and absorbency. Applicants again respectfully direct the Examiner's attention to the Examples of the present specification, and specifically Figures 1-9 which show the claimed products' superior characteristics over those of the prior art.

Applicants dispute that the prior art discloses products containing the same amount of cationic and anionic strength agents as that claimed. Specifically, all pending claims recite that the cationic wet strength agent is present in an amount of from 15 to 30 lbs/ton, and further that the ratio of cationic and anionic strength agents is controlled to achieve a net charge within a certain range. None of the cited references disclose an amount of cationic wet strength agent within the claimed range, nor do any of the references disclose that the ratio of the cationic to anionic strength agent is controlled to achieve close to a net charge balance. For example, *Dasgupta* teaches broadly that the ratio of anionic to cationic additives may range from 1/20 to 10/1, but the reference nowhere suggests a selection of the ratio based upon the net charge of the papermaking furnish.

Nor is the fact that, in the present invention, the ratio of anionic to cationic strength agents is controlled to achieve a net charge within a specific range "mere optimization." By controlling the ratio of cationic wet strength agent and anionic strength agent such that the net charge is zero or slightly anionic, the resulting web has excellent softness, absorbency, and strength. The Examiner has not set forth any teaching from the prior art which shows the claimed ranges for machine direction stretch, cross-

direction wet strength, or tensile modulus of stiffness which are achieved by the present invention.

The cited references simply do not disclose a web with the superior characteristics achieved by the present invention, in which the amount of cationic wet strength agent and anionic strength agent is controlled so that the net charge of the web when formed from an aqueous stream is maintained in the range of from less than about zero to about  $-115 \text{ meq} \times 10^{-6}$  per 10 ml. The Examiner therefore has failed to show that the cited prior art references, alone or in combination, teach or suggest each and every element of the claimed invention, as required by the *prima facie* case of obviousness.

The Examiner stated during the interview that he questioned whether the Declaration of Gary L. Worry, which was submitted with the response of September 18, 2003, was an appropriate showing since it did not address the disclosed cited prior art. Applicants submit that the Declaration of Gary Worry is an appropriate showing and establishes the unexpected superiority of the present invention. The present invention provides a method of making a paper towel product and a single-ply paper towel product that achieves high strength and softness. The towel of the present invention achieves levels of strength and softness above the levels known for single-ply paper towels. The properties of the paper towel according to the present invention meet or exceed the levels associated with other paper towel products, while having a lower basis weight.

Specifically, when the strength of a paper towel is increased without a corresponding increase in the basis weight of the paper towel, it is expected that the

softness of the paper towel will decrease. Additionally, when a paper towel is creped to increase the softness of the paper, it is expected that the strength will be reduced. As set forth in the Declaration of Gary L. Worry, and as shown in Declaration Figures 1 - 4, a creped paper towel of the present invention maintains high strength and softness, while having a lower basis weight than other single-ply paper towels.

The Examiner's attention is again directed to Figures 1 - 4 of the Declaration of Gary L. Worry. Figure 1 is a plot of the relationship between the scalar rating of the subjective feel of a towel in a monadic test versus the geometric mean wet tensile strength. A towel product according to the present invention is labeled F4-B and prior art towel products are labeled as KC Surpass® 50000, Scott 180, Scott Select® 189, and JR-065. While the towel product according to the present invention has a lower basis weight than each of the other samples, the paper towel exceeds or substantially achieves both the geometric mean wet tensile strength and the softness of the other paper towels. Of note, the only paper towel exhibiting comparable geometric mean wet tensile strength, the KC Surpass® 50000 paper towel, rated approximately 1 unit lower than the paper towel of the present invention in softness, where a difference of 0.3 units is considered significant.

Figure 2 is a plot of the relationship between the rating of the subjective sensory softness test versus the geometric mean wet tensile strength. Towel products according to the present invention are labeled F4-B, MH7, and MH8 and prior art towels are labeled KC Surpass® 50000, Scott Select® 189, and JR-065. As shown, each of the towel products made according to the present invention has a higher softness rating than the prior art paper towels, while exceeding or substantially achieving the geometric

mean wet tensile strength of the prior art towels. Specifically, each of the prior art towels had a scaled sensory softness of "0", meaning that each of the towels had generally the same softness. The paper towels of the present invention, on the other hand, had sensory softness of between about 0.6 and 1.2. A 0.4 softness difference is considered a significant improvement.

Figure 3 is a plot of the relationship between the scalar rating of the overall subjective perception of a towel (which is an indication of perceived softness and strength) in a monadic test versus the geometric mean wet tensile strength. A towel product according to the present invention is labeled F4-B and prior art towels are labeled KC Surpass® 50000, Scott 180, Scott Select® 189, and JR-065. The overall ratings of the paper towel of the present invention are higher than those of the prior art paper towels. Specifically, the monadic ratings of the paper towel of the present invention exceed all tested paper towels, except for the Scott 189 paper towel. However, the paper towel of the present invention has a geometric mean wet tensile strength of approximately 1250 g/3", while the Scott 189 towel has a geometric mean wet tensile strength of less than 1000 g/3". Additionally, the paper towel of the present invention has a basis weight that is lower than that of the Scott 189 towel by more than 6.5 lbs. per 3000 sq. foot ream, which represents a significant costs savings.

Finally, Figure 4 is a plot of the tensile modulus of stiffness (lower stiffness indicating higher softness) versus the geometric mean wet tensile strength. Towel products according to the present invention are labeled F4-B, MH7, and MH8, and prior art towels are labeled KC Surpass® 50000, Scott 180, Scott Select® 189, and JR-065. A paper towel of the present invention exceeds or substantially achieves the softness of



the prior art paper towels, while exceeding or substantially achieving the geometric mean wet tensile strength of the prior art towels. In addition, these superior results are achieved with paper towels having a lower basis weight. Importantly, this objective data regarding the softness of the paper towels agrees with the subjective monadic data set forth in Figures 1 and 2.

Thus, while it is generally expected that increasing the strength of a paper towel product will reduce the softness of the paper towel, it is clear from Figures 1 - 4 that the paper towel of the present invention achieves equivalent or superior softness and geometric mean wet tensile strength, while having a lower basis weight than prior art paper towels.

Regarding *Dasgupta*, *Ostendorf et al.* and *Van Phan et al.*, none teach a towel product having qualities superior to those of the compared paper towel products. Further, none of the examples in these patents show the claimed ranges for machine direction stretch, cross-direction wet strength, or tensile modulus of stiffness which are achieved by the present invention, and recited in the pending claims. Still further, these references do not teach compositions which possess the characteristics of the claimed products, nor would it have been obvious to one of skill in the art to obtain these characteristics by merely optimizing the amount of wet strength agent, softening agents, or foreshortening of the web as disclosed in the prior art. Accordingly, claims 16 and 24, as well as claims 17 - 23 and 25 - 30 that depend therefrom are in condition for allowance.


In view of the foregoing remarks, Applicants respectfully request the reconsideration and further examination of this application and the timely allowance of

the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: May 17, 2004

By:   
Reg No 44033  
Lori-Ann Johnson  
Reg. No. 34,398